

## REMARKS

In the Office Action dated November 22, 2002, claims 1-37 were pending and stand rejected. Applicants respectfully traverse these rejections as follows.

### I. Ballantyne in view of Reber

Claims 1-3, 5, 7-16, 19-23, 24-26, 28, and 30-35 stand rejected as unpatentable over U.S. Patent No. 5,867,821 to Ballantyne in view of U.S. Patent No. 5,961,451 to Reber.

Applicants traverse these rejections on the basis that the Office Action fails to establish *prima facie* obviousness of the rejected claims on the basis that no motivation exists to combine the Ballantyne and Reber references. In order to establish *prima facie* obviousness, there "must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art...." (MPEP 2143). In this regard, the Office Action states as follows.

It would have been obvious to one in the art at the time of the invention to combine the electronic wellness information of Ballantyne et al. with the sensor/measuring device of Reber et al., because the system would be more effective due to increased accuracy of measurements during hospital stays and home use. Furthermore, because the system would be electronically automated there is less of a chance of human error. The result of lowering error when taking a physiological measurement would cause system [sic] to distribute more accurate information to the patient. (Office Action, Paragraph 2, Pages 2-3).

Applicants submit that neither Ballantyne nor Reber teach or suggest the alleged motivation for combining the teachings of Ballantyne and Reber. Ballantyne does not disclose the need for improved accuracy. Reber is directed to noninvasively extracting biological samples and not to improving accuracy of a health care information system. Indeed, Reber does not teach or suggest improved accuracy.

In addition, Applicants submit that this motivation is not in the knowledge generally available to one of ordinary skill in the art. To the extent the Examiner maintains this position, Applicants request that the Examiner cite a prior art reference in support of such a position. Accordingly, because no motivation exists to combine Ballantyne and Reber as proposed in the Office Action, Applicants submit that the Office Action fails to establish

LAW OFFICES OF  
SKJERVEN MORRILL LLP  
San Jose, CA  
San Francisco, CA

*prima facie* obviousness of claims 1-3, 5, 7-16, 19-23, 24-26, 28, and 30-35. Withdrawal of these rejections is requested.

In addition, Applicants submit that the Office Action fails to establish *prima facie* obviousness of claim 1 on the basis that Ballantyne in view of Reber does not teach or suggest all claim limitations. (See, MPEP 2143.03, “To establish *prima facie* obviousness, of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”).

Claim 1 recites “the controller including: logic for controlling the health test interface to perform measurements on a user to acquire health test measurement data.” Applicant submits that neither Ballantyne nor Reber disclose this feature. In this regard, the Office Action states “...Ballantyne does not disclose logic for controlling a health care interface that performs measurements on a user.” Reber also fails to disclose the recited logic, but merely discloses an apparatus including sensors, a processor, memory, a power supply, and a display. Reber fails to disclose “logic for controlling the health test interface to perform measurements on a user to acquire health test measurement data” as claimed in claim 1. Accordingly, Applicants submit that claim 1 is non-obvious over Ballantyne in view of Reber for this additional reason.

Claims 2-3, 5, and 7-13 depend upon claim 1 and are allowable for at least the same reasons as claim 1 is allowable. Withdrawal of this rejection is requested.

Claim 14 is also further non-obvious by reciting “storage elements respectively allocated to the plurality of users.” Ballantyne discloses that the master library 2 “acts as a medical data depository” (Col. 4, line 4). However, Ballantyne does not teach or suggest storage elements respectively allocated to a plurality of users. Indeed, Ballantyne is silent regarding allocation of storage elements. Reber also fails to disclose this feature. Accordingly, Applicants submit that the Office Action fails to establish *prima facie* obviousness of claim 14 because Ballantyne in view of Reber fails to disclose all limitations of claim 14. (See, MPEP 2143.03).

Further, claim 14 also recites “the controller having the ability to appraise user health care risk on the basis of diagnostic data....” In contrast, the stations 6, 8 of Ballantyne do not “appraise user health care risk”. Reber also fails to disclose this feature. Accordingly, claim 14 is non-obvious over Ballantyne in view of Reber because neither of these references, nor

their combination disclose “the controller having the ability to appraise user health care risk on the basis of diagnostic data....” (See, MPEP 2143.03). Withdrawal of the rejection of claim 14 is requested for this additional reason.

Claims 15, 16, and 19-23 depend upon claim 14 and are allowable for at least the same reasons that claim 14 is allowable. Withdrawal of these rejections is requested.

Claim 24 is also non-obvious by at least reciting “executing instructions at the controller including: controlling the diagnostic equipment to perform a health test measurement on a user.” Applicants submit that Ballantyne in view of Reber does not suggest that the controller executes instructions for controlling diagnostic equipment. Reber discloses an apparatus capable of transmitting data to a network. Ballantyne does not teach or suggest that the stations 6, 8 control diagnostic equipment. Accordingly, because Ballantyne in view of Reber does not disclose all claim limitations of claim 24, the Office Action fails to establish *prima facie* obviousness of claim 24 over Ballantyne in view of Reber. Withdrawal of this rejection is requested.

Claims 25, 26, 28, 30-35 depend upon claim 24 and are allowable for at least the same reasons as claim 24 is allowable. Withdrawal of this rejection is requested.

## II. **Ballantyne in view of Cosentino**

Claims 1, 4, 6, 17-18, 27, 29, and 36-37 stand rejected as unpatentable over Ballantyne in view of U.S. Patent No. 6,290,646 to Cosentino. Applicants respectfully traverse this rejection as follows.

Applicants traverse these rejections on the basis that the Office Action fails to establish *prima facie* obviousness of the rejected claims on the basis that no motivation exists to combine the Ballantyne and Cosentino references. In order to establish *prima facie* obviousness, there “must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art....” (MPEP 2143). In this regard, the Office Action states as follows.

It would have been obvious to one in the art at the time of the invention to combine the electronic wellness information of Ballantyne et al. with the scale of Cosentino et al., because the system would be more effective due to increased accuracy of measurements during hospital stays and home

LAW OFFICES OF  
SKJERVEN MORRILL LLP  
  
San Jose, CA  
San Francisco, CA

use. Furthermore, because the system would be electronically automated there is less chance of human error. The result of lowering error when taking a physiological measurement would cause system [sic] to distribute more accurate information to the patient. (Office Action, Paragraph 3, Pages 3-4).

Applicants submit that neither Ballantyne nor Cosentino teach or suggest the alleged motivation for combining the teachings of Ballantyne and Cosentino. Ballantyne does not disclose the need for improved accuracy. Cosentino is directed to communicating measured parameters to a computer located at a remote site and not to improving accuracy of a health care information system. Indeed, Cosentino does not teach or suggest improved accuracy.

In addition, Applicants submit that this motivation is not in the knowledge generally available to one of ordinary skill in the art. To the extent the Examiner maintains this position, Applicants request that the Examiner cite a prior art reference in support of such a position. Accordingly, because no motivation exists to combine Ballantyne and Cosentino as proposed in the Office Action, Applicants submit that the Office Action fails to establish *prima facie* obviousness of claims 1, 4, 6, 17-18, 27, 29, and 36-37. Withdrawal of these rejections is requested.

In addition, Applicants submit that the Office Action fails to establish *prima facie* obviousness of claim 1 on the basis that Ballantyne in view of Cosentino does not teach or suggest all claim limitations. (See, MPEP 2143.03, “To establish *prima facie* obviousness, of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”).

Claim 1 recites “the controller including: logic for controlling the health test interface to perform measurements on a user to acquire health test measurement data.” Applicants submit that neither Ballantyne nor Cosentino disclose this feature. In this regard, the Office Action states “...Ballantyne does not disclose logic for controlling a health care interface that performs measurements on a user.” Cosentino also fails to disclose the recited logic. Indeed, neither the Cosentino remote computer 32 nor the microprocessor 24 control the scale 18. Accordingly, because neither Ballantyne nor Cosentino teach or suggest a control including logic for “controlling the health test interface” Applicants submit that the Office Action fails to establish *prima facie* obviousness.

Claims 4 and 6 depend upon claim 1 and are allowable for at least the same reasons as claim 1 is allowable. Withdrawal of these rejections is requested.

Claims 17 and 18 depend upon claim 14 and are allowable for at least the same reasons as claim 14 is allowable. Withdrawal of this rejection is requested.

Claims 27 and 29 depend upon claim 24 and are allowable for at least the same reasons as claim 24 is allowable. Withdrawal of this rejection is requested.

Claim 36 is non-obvious over Ballantyne in view of Cosentino at least by reciting "executing instructions at the controller including: processing the health test measurement to produce a health care test result for a user." The Ballantyne stations 6, 8 do not perform processing of a health test measurement to produce a health care test result as recited in claim 36. Rather, the stations 6, 8 forward entered information to the master library 2. Accordingly, because Ballantyne in view of Cosentino does not teach all limitations of claim 36, Applicants submit that the Office Action fails to establish *prima facie* obviousness of claim 36. Withdrawal of this rejection is requested.

Applicants submit that the Office Action fails to establish *prima facie* obviousness of claim 37 on the basis that no motivation exists to combine the Ballantyne and Cosentino references, as discussed above. Withdrawal of this rejection is requested.

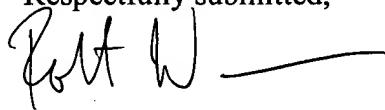
### CONCLUSION

Applicants submit that the present application is in condition for allowance and request such action. Should there be any questions concerning this response, the Examiner is invited to call the undersigned at (415) 217-6000.

EXPRESS MAIL LABEL NO:

EV 259 160 095 US

Respectfully submitted,



Robert D. Wasson  
Attorney for Applicant(s)  
Reg. No. 40,218

LAW OFFICES OF SKJERVEN MORRILL LLP  
Three Embarcadero Ctr., 28th Floor  
San Francisco, CA 94111

LAW OFFICES OF  
SKJERVEN MORRILL LLP  
  
San Jose, CA  
San Francisco, CA